

REMARKS

This Application has been carefully reviewed in light of the Advisory Action mailed May 16, 2005. In order to advance prosecution of this Application, Claims 1-3, 10-13, 16, 17, and 20 have been amended. Applicant respectfully requests reconsideration and favorable action in this Application.

The Examiner issued a Final Action on March 3, 2005. Applicant submitted a Response to Examiner's Final Action on May 3, 2005. The Examiner issued an Advisory Action on May 16, 2005 stating that the Response to Examiner's Final Action would not be entered because it raised new issues requiring further searching and consideration. Applicant respectfully requests continued examination of this Application so that the Response to Examiner's Final Action be entered and considered by the Examiner pursuant to this Request for Continued Examination. For the convenience of the Examiner, the amendments made to the claims in the Response to Examiner's Final Action and the accompanying comments are repeated herein.

With respect to Claims 6, 7, and 9 withdrawn by the Examiner, Applicant respectfully submits that these claims depend from a generic claim, Claim 1. Therefore, Applicant respectfully requests reinstatement of Claims 6, 7, and 9.

The drawings stand objected to under 37 C.F.R. §1.83(a) as not showing every feature of the invention specified in the claims. Applicant is confused as to the objection to the replacement drawing submitted with the previous response. A midsole described in the specification and presented in the claims was not shown in the elected FIGURE 14. FIGURE 14 was amended as requested by the Examiner to show a simple midsole as provided in the claimed invention. The specification recites "[i]nsole 816 may be in direct contact with surface

818 of outsole 812 or may be separated therefrom by one or more midsoles 829." See page 29, lines 11-13, of Applicant's specification. Further support for a midsole can be found at page 22, lines 9-12, of Applicant's specification. The midsole added by amendment to FIGURE 14 falls well within the confines of the specification. Thus, no new matter was added with the insertion of the midsole to FIGURE 14. An amended FIGURE 14 is being provided to reposition reference numeral 824 so that it coincides with the midpoint of the insole. Therefore, Applicant respectfully submits that the drawings are in accordance with 37 C.F.R. §1.83(a).

Claims 1-5, 8, 10-20 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Claims 1-3, 10-13, 16, and 17 have been amended to address matters raised by the Examiner. Therefore, Applicant respectfully submits that Claims 1-5, 8, 10-20 are in accordance with 35 U.S.C. §112, second paragraph.

Claims 11 and 16 stand rejected under 35 U.S.C. §102(b) as being anticipated by Lodispoto. Independent Claims 11 and 16 recite in general an upper, an insole being a single piece layer and having a forward toe section and a rear heel section that place a wearer's foot in a position where the wearer's heel is closer to a walking surface than the wearer's toes during normal wearing conditions or a dorsiflexion position, and an outsole. By contrast, the top member or insole of the wooden shoe in the Lodispoto patent cannot by itself place a wearer's foot in position where a wearer's heel is closer to a walking surface than a wearer's toes as provided in the claimed invention without the functionality of its bottom member. The Lodispoto patent clearly shows a raised heel portion that prevents a wearer's heel from being closer to a walking surface than a wearer's toes as required in the

claimed invention. See the Abstract of the Lodispoto patent and the upwardly bent backend stretch 28. Therefore, Applicant respectfully submits that Claims 11 and 16 are not anticipated by the Lodispoto patent.

Claims 1-5, 10-13, and 16-19 stand rejected under 35 U.S.C. §102(b) as being anticipated by Robinson. Independent Claims 1, 11, and 16 recite in general an insole being a single piece layer of the shoe and having a forward toe section and a rear heel section that place a wearer's foot in a position where the wearer's heel is closer to a walking surface than the wearer's toes during normal wearing conditions or in a dorsiflexion position. By contrast, the insole 30 of the Robinson patent is substantially planar and cannot provide the structure by itself as provided by the claimed invention without the use of a separate reverse wedge positioned under the insole. Thus, the Robinson patent does not provide an insole that is a single piece layer for the shoe as required in the claimed invention. Therefore, Applicant respectfully submits that Claims 1-5, 10-13, and 16-19 are not anticipated by the Robinson patent.

Claims 1-5, 10-13, and 16-19 stand rejected under 35 U.S.C. §102(b) as being anticipated by Snabb, et al. As stated above, the claimed invention requires an insole having a forward toe section and a rear heel section that place the wearer's heel closer to a walking surface than the wearer's toes or in a dorsiflexion position. By contrast, the Snabb, et al. patent uses an outsole to attempt to provide the claimed structure. The inner sole of the Snabb, et al. patent is clearly shown to be flat in FIGURE 5 and is only sloped from front to rear due to the shape of its outsole. See col. 3, lines 29-31, of the Snabb, et al. patent. Thus, the inner sole of the Snabb, et al. patent does not provide the

capabilities of the claimed invention. Moreover, Claims 4, 13, and 18 require that the structure of the insole changes at a substantially halfway point along the shoe. The Snabb, et al. patent clearly shows the change in structure at point 28 of the toe area of the shoe, well away from the halfway point of the shoe. Therefore, Applicant respectfully submits that Claims 1-5, 10-13, and 16-19 are not anticipated by the Snabb, et al. patent.

Claims 8, 14, and 20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Robinson or Snabb, et al. Independent Claim 1, from which Claim 8 depends; Independent Claim 11, from which Claim 14 depends; and Independent Claim 16, from which Claim 20 depends, have been shown above to be patentably distinct from the Robinson and Snabb, et al. patents. Therefore, Applicant respectfully submits that Claims 8, 14, and 20 are patentably distinct from the Robinson and Snabb, et al. patents.

Claims 15 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Robinson or Snabb, et al. Independent Claim 11, from which Claim 154 depends, has been shown above to be patentably distinct from the Robinson and Snabb, et al. patents. Therefore, Applicant respectfully submits that Claim 15 is patentably distinct from the Robinson and Snabb, et al. patents.

Claims 1-5, 8, and 10-20 stand rejected under the judicially created doctrine of double patenting over Claims 1-6 of U.S. Patent No. 6,131,315 in view of either Lodispoto, Robinson, or Borgeas. U.S. Patent No. 6,131,315 only provides disclosure through FIGURE 10 and does not include a FIGURE 14 of the elected species or any disclosure associated therewith as provided in Applicant's specification. Thus, the elected species of FIGURE 14 is not disclosed in U.S. Patent No.

6,131,315. Therefore, Applicant respectfully submits that a Terminal Disclaimer is not necessary in this Application with respect to U.S. Patent No. 6,131,315.

Attached herewith is a check in an amount of \$395.00 made payable to the "Commissioner of Patents and Trademarks" to satisfy the request for continued examination fee of 37 C.F.R. §1.17(e).

CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests full allowance of all pending claims.

If there are matters that can be discussed by telephone to advance prosecution of this Application, Applicant invites the Examiner to contact the undersigned attorney at the number provided below.

The Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.

Attorneys for Applicant

A handwritten signature in black ink, appearing to read "Charles S. Fish", with a stylized flourish at the end.

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